Supreme Court, U.S.
FILED

981492 MAR 16 1999

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No.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1998

PUBLICATIONS INTERNATIONAL, LTD.,

Petitioner,

v.

LANDOLL, INC.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Did the Court of Appeals find the trade dress of Petitioner's cookbooks and children's books to be insufficiently distinctive for trade dress protection without applying any standard of law?

2. Does the decision of the Court of Appeals conflict with decisions of the other Circuits as to the standards for distinctiveness of trade dress and the burden of proof on the issue of functionality of trade dress?

3. Did the Court of Appeals improperly apply the concept of aesthetic functionality to utilitarian cookbooks and children's books?

PARTIES TO THE PROCEEDING

Publications International, Ltd., brought this proceeding against Landoll, Inc. Publications International, Ltd., has no parent company, nor is it a non-wholly owned subsidiary of any other company or corporation.

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OPINIONS BELOW

The opinion of the Court of Appeals is reported at 164 F.3d 337, and is reproduced at page 1 of the Appendix to this Petition. The opinion of the district court is reported at 45 U.S.P.Q. 2d 1277, 1997 WL 769349 and is reproduced commencing at page 13 of the Appendix to this Petition.

STATEMENT OF JURISDICTION

The judgment of the Court of Appeals for the Seventh Circuit was entered on December 16, 1998. No petition for rehearing was filed. This Petition for Writ of Certiorari is filed within ninety days of the entry of the Court of Appeals' judgment. The jurisdiction of this court rests on 28 U.S.C. §1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Amend. VII to the United States Constitution

In suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rules of the common law.

The Lanham Act, 15 U.S.C. §1125. False designation of origin, false descriptions, and dilution forbidden

(a) Civil Action

(1) Any person who, or in connection with any goods or services, or any container for goods, uses in com-

merce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

STATEMENT OF THE CASE

Petitioner, Publications International, Ltd., respectfully prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit affirming the decision of the United States District Court for the Northern District of Illinois, granting summary judgment for defendant.

This cause was brought by plaintiff pursuant to the Lanham Act, 15 U.S.C. §1125, alleging defendant had infringed the trade dress of plaintiff's cookbooks and children's storybooks. The district court granted defendant's motion for summary judgment and entered judgment for defendant, which judgment was affirmed by the Court of Appeals.

Petitioner (hereinafter referred to as "PIL") has been in the business of publishing books for nearly twenty-five years. Cookbooks have been one of its specialties. In 1993, it began producing large, heavy cookbooks containing 684 pages, a page size (trim size) of 8½" x 11", with padded, high-gloss covers and page edges gilded in gold. No one had ever published cookbooks in that format before. These books instantly became hugely successful. PIL selected that trade dress because it was distinctive, unique and arbitrary. It was chosen to distinguish and identify the books as coming from PIL. When these cookbooks were first produced, one of Plaintiff's officers observed that PIL had succeeded in producing the "Mother of All Cookbooks." Shortened to its acronym "M.O.A.C.," they have been uniformly described by that catch-phrase internally at PIL and by its customers, many of whom order them by the use of that term. Similarly, the children's line of books is uniformly referred to as "Treasuries" by both PIL and its customers.

Between their introduction in 1993, and mid-February, 1997, PIL had sold nearly three million copies of the cookbooks containing this trade dress for gross sales of over twenty-three million dollars. Wishing to build on the huge success of these cookbooks, in 1994 PIL adapted this trade dress for its line of children's storybooks, reducing the page size slightly, and reducing the number of pages in the book to 384 pages. In all other respects the trade dress was the same. Those books were hugely successful as well. Between their introduction in late 1994 and early 1997, PIL sold over two million copies of these children's treasuries with gross sales of over thirteen million dollars.

Early in 1995, Respondent Landoll began publishing cookbooks and children's books containing the identical trade dress of PIL's books. They were the same page size, same page count, having padded, high-gloss covers, with the page edges gilded in gold. Landoll used the same printer for its books as PIL was using—a printer with whom Landoll had never before done business. Not surprisingly, Landoll's books had the same look and feel as PIL's books. PIL then brought this action under the Lanham Act seeking injunctive relief and damages.

Landoll filed a motion for summary judgment, based upon the single assertion that since PIL's trade dress was not inherently distinctive, Landoll had the freedom to slavishly copy that format. Acknowledging the confusion as to the appropriate test to be applied in deciding the issue of trade dress in the context of product configuration, the district court concluded PIL's alleged trade dress was not sufficiently "unique, unusual or unexpected" in the book market to "automatically be perceived . . . as an indicator of origin" finding it to be a mere refinement of existing ornamentation. Although stating that it was not ruling upon the issue of functionality, the district court nevertheless found that the elements of Plaintiff's claimed trade dress make the product more desirable to consumers, a "deluxe" product, thereby rendering them functional and not entitled to trade dress protection. (Appendix, 34) The district court therefore entered summary judgment for Landoll.

The Court of Appeals affirmed. Acknowledging that the courts have struggled to articulate a standard to determine when a trade dress is sufficiently distinctive

to be entitled to the protection of the Lanham Act, the court simply concluded that "efforts to define intuitive concepts such as 'distinctiveness' are often both futile and unnecessary." (Appendix, 2) In an opinion that can only be described as murky, the Court of Appeals found each of the features of PIL's trade dress to be "functional,"[1] but acknowledged that a combination of functional features may turn out to be distinctive enough for trade dress protection. (Appendix, 9) Without giving any explanation or applying any discernible test, the court concluded that neither PIL's cookbooks nor children's books were sufficiently distinctive to be entitled to trade dress protection[2] because they were just another "*type* of cookbook." (Appendix, 10, emphasis in original)

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[1] With virtually no evidentiary support in the record, the Court of Appeals held the various elements of PIL's cookbooks to be functional because a) large pages lay flat in the kitchen while the cook is using the book; b) large print is easy to read; c) recipe is on one page and the picture of the dish is on the facing page, making it easier to see what the food is supposed to look like when completed; d) shiny oilcloth covers makes the book easier to clean; and e) gilding on the pages masks "bleeding" of the photographs onto the edge of the pages. The court even went so far as to invoke aesthetic functionality in regard to the use of gold gilding on the book's pages. (Appendix, 8)

[2] Again, without any support in the record, the court opined that the children's books were "functional" because the gilding prevented "bleeding" of the pictures onto the edges of the pages, they were easy to clean off children's dirty fingerprints, and "children love gold." (Appendix, 11)

REASONS FOR GRANTING THE WRIT

I.

THERE IS NO ASCERTAINABLE UNIFORM STANDARD OF DISTINCTIVENESS TO DETERMINE WHETHER ANY TRADE DRESS IS ENTITLED TO PROTECTION

Both the district court and the Court of Appeals acknowledged difficulty in conceptualizing what makes a trade dress sufficiently distinctive to entitle it to protection under the Lanham Act. 15 U.S.C. §1125(a). In the end, the Court of Appeals gave up trying to articulate the reason for its decision, merely concluding PIL's books were "just another type" of book, as dictionaries, encyclopedias, atlases, law books and comic books are "types" of books. (Appendix, 10) Such cavalier treatment of serious business issues is simply unacceptable.

In *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773, 112 S.Ct. 2753, 2760, 120 L.Ed.2d 615 (1992), this Court held that a product with an inherently distinctive configuration is capable of identifying that product as coming from a specific source and is therefore entitled to trademark protection, without a showing of secondary meaning. Since then, the courts have made a hopeless jumble of what is sufficiently distinctive to entitle a product configuration to trade dress protection. The decision by the Court of Appeals in this case is the culmination of that confusion. Rather than articulate a basis for its conclusion, the court has simply relied upon an "intuitive" impression of the product in reaching its result. Unfortunately, everyone's intuition is not the same. This approach provides no guidance whatsoever to anyone wishing to assert trade dress rights or to those wishing to know whether they may copy the

features of another's product or not. Under this approach, the answer can be given only after extended and expensive litigation. Moreover, the result of such litigation under this scenario is variable in each instance and impossible to predict.

The parties both sell their goods nationally. This suit involves a federal statute, which should be applied to all throughout the country consistently. Neither the rights of these parties, nor the rights of any other national manufacturers, should vary depending upon which court in which geographical area of the country happens to hear the case. However, as we discuss below, currently those rights will be greatly different depending upon which court happens to consider them.

The courts of appeals have not been able to agree on a definition of distinctiveness. The Seventh Circuit has not adopted a definition for inherent distinctiveness in product configuration trade dress cases. *Sassafras Enterprises, Inc. v. Roshco, Inc.*, 915 F. Supp. 1, 5 (N.D. Ill. 1996). Although it had the perfect opportunity to adopt a definition in this case, it did not do so, but instead, opted to decide the case based upon the court's visceral impression of the product, instead of allowing a jury to decide the issue under proper directions after a trial at which each side was able to fully develop its evidence. It used a novel theory of functionality as a substitute for distinctiveness. Rather than decide whether the books were sufficiently distinctive to be capable of identifying their source, the court castigated PIL for not having used a "traditional" trademark to distinguish its books from those who might copy its product. (Appendix, 10) Not only is this contrary to the clear terms of the Lanham Act, but it eviscerates this

Court's holding that a product with an inherently distinctive configuration is entitled to protection with no showing of secondary meaning. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773, 112 S.Ct. 2753, 2760, 120 L.Ed.2d 615 (1992).

PIL's books are unquestionably unique. The combination of elements PIL uses for its books is arbitrary and under any standard is inherently distinctive. That they may incorporate several common design elements found in other books but combine them in a novel manner does not render them non-protectable. *Taco Cabana, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1120 (5th Cir. 1991); *Computer Care v. Service Systems Enterprises, Inc.*, 982 F.2d 1063, 1069 (7th Cir. 1992). While purporting to recognize this precept, the Court of Appeals then ignored it in reaching the conclusion that PIL's products were just another "type" of book without any factual basis upon which to rest that statement. Thus, the decision here is in direct conflict with other courts which have reached the contrary conclusion. "One could no more deny protection to a trade dress for using commonly used elements than one could deny protection to a trademark because it consisted of a combination of commonly used letters of the alphabet." *Paddington Corp. v. Attiki Importers & Distributors, Inc.*, 996 F.2d 577, 584 (2nd Cir. 1993).

As a result of the utter confusion between the approaches of the various courts of appeals as to the definition of distinctiveness, no manufacturer is able to determine whether its product has a trade dress which is entitled to protection. Whether it will be entitled to protect a product configuration will depend upon the happenstance of which court decides the issue. Compet-

itors have no reasonable way of determining whether they are infringing the rights of another. Whether they are guilty of infringement, and potentially subject to millions of dollars in damages, depends upon where suit is filed against them. Such important rights ought not depend upon who wins the race to the courthouse.

In *Two Pesos, Inc. v. Taco Cabana, Inc.*, supra, this Court endorsed the classic categories of distinctiveness set forth in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2nd Cir. 1976): (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary or (5) fanciful. 505 U.S. at 768. Since then, several courts have departed from this test when deciding whether product configuration is entitled to trade dress protection. The evolutionary paths are vastly inconsistent. The Fifth Circuit has adopted the *Abercrombie* test. *Pebble Beach Co. v. Tour 18 Ltd.*, 155 F.3d 526, 540 (5th Cir. 1998); *Sunbeam Products, Inc. v. The West Bend Co.*, 123 F.3d 246, 252 (5th Cir. 1997), cert. denied, 118 S.Ct. 1795, 140 L.Ed.2d 936 (1998). The Eleventh Circuit seems to follow *Abercrombie* also. *University of Florida v. KPB, Inc.*, 89 F.3d 773, 776 (11th Cir. 1996). While the Second Circuit uses the *Abercrombie* test for a product's packaging in trade dress cases it, for a time, appeared to use an entirely different test in discussing product design and configuration trade dress. In order to qualify for trade dress protection, the manufacturer of a product was required to show the design was primarily intended as source identification, focusing on the intent of the manufacturer, rather than the reaction of the consumer. *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2nd Cir. 1995).

The Second Circuit's two latest decisions on the issue seem to have adopted a different approach, however. In

Samara Brothers, Inc. v. Wal-Mart Stores, Inc., 165 F.3d 120 (2nd Cir. 1998), the court upheld a jury award of over a million dollars, based upon a finding that a line of clothing was sufficiently distinctive to enjoy trade dress protection, because the evidence at the trial depicted a "distinctive combination of ingredients" in the trade dress, warranting Lanham Act protection, as the design was "likely to be understood as an indicator of the product's source." Similarly, In *Nora Beverages, Inc. v. Perrier Group of America, Inc.*, 164 F.3d 736 (2nd Cir. 1998), decided at about the same time, the Second Circuit reversed a summary judgment order based upon a finding of non-distinctiveness of a bottle for spring water, and remanded the case for a jury trial because the plaintiff's evidence that its bottle design was unique at the time of its introduction into the market raised a genuine factual dispute which required a jury trial. This approach is correct. It is consonant with the prior teaching of this Court, and the majority of the decisions of the courts of appeals.

The decision of the court below in this case is directly contrary to the holdings of the Second Circuit in these two cases. PIL's cookbooks and children's books are undoubtedly as distinctive as the clothes and bottles considered by the Second Circuit in *Samara Brothers* and *Nora Beverages*. Had this case been considered by the Second Circuit, rather than the Seventh, Landoll's summary judgment motion would have been denied and the case set for a trial before a jury.[3]

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[3] The Seventh Circuit's decision effectively abrogated PIL's Seventh Amendment right to a trial by jury. Trademark cases

(continued...)

The First Circuit has stated that inherent distinctiveness of a product design should be determined by reference to whether the design is a "common" basic shape or design, whether it was unique or unusual in a particular field, whether a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods or whether it is capable of creating a commercial impression distinct from accompanying words. *Wiley v. American Greeting Cards*

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[3] (...continued)

present legal claims triable by a jury as a matter of right. *Dairy Queen, Inc. v. Wood*, 369 U.S. 469, 82 S.Ct. 894, 8 L.Ed. 2d 44 (1962). It is well settled that distinctiveness is a question of fact to be decided by a jury. *Boston Beer Co. v. Slesar Bros. Brewing Co. Inc.*, 9 F.3d 175, 180 (1st Cir. 1993); *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1039-40 (2nd Cir. 1992); *Imagineering, Inc. v. Van Klassens, Inc.*, 53 F.3d 1260, 1263 (Fed. Cir. 1995). It is equally well settled that functionality is also question of fact to be decided by a jury. *Inwood Laboratories, Inc. v. Ives Laboratories*, 456 U.S. 844, 102 S.Ct. 2182, 72 L.Ed.2d 606 (1982); *Fun-Damental Too, Ltd. v. Gemmy Industries Corp.*, 111 F.3d 993, 1002 (2nd Cir. 1997); *Hupp v. Siroflex*, 122 F.3d 1456 (Fed. Cir. 1997). The Seventh Circuit's decision is tantamount to a rejection of this proposition, turning the issues of distinctiveness and functionality into questions of law. This is an invasion of the province of the jury.

The right to a jury trial has constitutional implications, as this Court recently recognized this last term in *Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340, 118 S.Ct. 1279, 140 L.Ed.3d 438 (1998), where it was reiterated that the Seventh Amendment guarantee of a jury trial applies not only to common-law causes of action, but also to "actions brought to enforce statutory rights that are analogous to common-law causes of action ordinarily decided in English law courts in the late 18th century, as opposed to those customarily heard by courts of equity or admiralty." PIL has been deprived of its constitutional right to have those issues tried by a jury.

Corp., 762 F.2d 139 (1st Cir. 1985); *I.P. Lund Trading Aps. v. Kohler Co.*, 163 F.3d 27 (1st Cir. 1998). The Eighth Circuit seems to have used this approach as well in *Children's Factory, Inc. v. Benee's Toys, Inc.*, 160 F.3d 489, 494 (8th Cir. 1998), although it had previously used the *Abercrombie* test. *Insty*Bit, Inc. v. Poly-Tech Industries, Inc.*, 95 F.3d 663, 673 (8th Cir. 1996).

The Third Circuit has developed a highly restrictive test requiring that the design owner prove that the product configuration is "(i) unusual and memorable; (ii) conceptually separable from the product; and (iii) likely to serve primarily as a designator of origin of the product. *Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd.*, 40 F.3d 1431, 1449 (3rd Cir. 1994).

Like the Seventh Circuit in this case, the Ninth and Tenth Circuits seem to have abandoned any attempt to define distinctiveness, opting instead for language which merely identifies the result. Thus, the Ninth Circuit has stated, "a mark or dress is distinctive when it identifies the particular source of the product or distinguishes it from other products." *International Jensen, Inc. v. Metrosound U.S.A., Inc.*, 4 F.3d 819, 824 (9th Cir. 1993). Similarly, the Tenth Circuit states that a product's features are inherently distinctive "because their intrinsic nature is such as to almost automatically tell a customer that they refer to a brand." *Vornado Air Circulation Systems, Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1502 (10th Cir. 1995), cert. denied, 516 U.S. 1067, 116 S.Ct. 753, 133 L.Ed.2d 700 (1996).

How is any business to know what its rights are in this area? This is not a mere theoretical quibble. Mil-

lions of dollars are at stake in many of these cases. See *Samarra Brothers, Inc. v. Wal-Mart Stores, Inc.*, 165 F.3d 120 (2nd Cir. 1998). This is an issue which cries out for this Court's guidance.

II.

THERE IS HOPELESS CONFUSION AMONG THE CIRCUITS REGARDING FUNCTIONALITY

The conflict regarding functionality is just as pronounced. As the Court of Appeals in this case acknowledged, the circuits do not agree on which party has the burden of proving functionality. The court here brushed that difference of opinion aside as being of little relevance, since both sides have access to the same information, and it matters little who introduces the evidence which (presumably) will be introduced in any event. (Appendix, 5) This is simply untrue, particularly when dealing with motions for summary judgment, where which party bears the burden of proof is of the utmost importance.[4]

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[4] The Fourth, Second, Seventh and Tenth Circuits place the burden of proving functionality on the defendant. *Shakespeare Co. v. Silstar Corp.*, 110 F.3d 234 (4th Cir. 1997); *LeSportsac, Inc. v. Kmart Corp.*, 754 F.2d 71, 75-76 (2nd Cir. 1985); *Computer Care v. Service System Enterprises, Inc.*, 982 F.2d 1063, 1068 (7th Cir. 1992); *Vornado Air Circulation Systems, Inc. v. Duracraft Corp.*, 58 F.3d 1498 (10th Cir. 1995), cert. denied, 516 U.S. 1067, 116 S.Ct. 753, 133 L.Ed.2d 700 (1996).

The First, Third, Fifth, Sixth, Eighth, Ninth and Eleventh Circuits place the burden on the plaintiff to show that its product's features are nonfunctional. *Fisher Stoves, Inc. v. All Nighter Stove Works, Inc.*, 626 F.2d 193 (1st Cir. 1980); *CIBA-GEIGY Corp. v. Bolar Pharmaceutical Co.*, 747 F.2d 844 (3rd

(continued...)

Of even more importance, however, is the proper definition of functionality. The courts have been unable to agree in this area either. All courts agree, and it can hardly be disputed, that if a feature is functional, it is likely that all similar articles will have a similar functional feature, and one seller's feature is not likely to evoke any response in buyers that it is a unique or distinctive symbol of origin. *I.P. Lund Trading Aps. v. Kohler Co.*, 163 F.3d 27 (1st Cir. 1998). Since the policy of the Lanham Act is to promote competition, protection will not be accorded a trade dress when to do so prevents another from competing effectively. *Fun-Damental Too, Ltd. v. Gemmy Industries Corp.*, 111 F.3d 993, 1002 (2nd Cir. 1997).

Functionality means that the entire trade dress, taken as a whole, is functional, not just certain component parts. It means that the trade dress is one that would be found in most or all brands of the product, even if no producer had any desire to have his brand mistaken for that of another. *Computer Care v. Service Systems Enterprises, Inc.*, 982 F.2d 1063, 1068 (7th Cir. 1992).

In this case, there is no evidence whatsoever that the number of designs available for cookbooks and chil-

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[4] (...continued)

Cir. 1984); *Sunbeam Products, Inc. v. West Bend Co.*, 123 F.3d 246 (5th Cir. 1997), cert. denied, 118 S.Ct. 1795, 140 L.Ed.2d 936 (1998); *Kwik-Site Corp. v. Clear View Mfg. Co.*, 758 F.2d 167 (6th Cir. 1985); *Woodsmith Publishing Co. v. Meredith Corp.*, 904 F.2d 1244 (8th Cir. 1990); *Rachel v. Banana Republic, Inc.*, 831 F.2d 1503 (9th Cir. 1987); *Ambrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531 (11th Cir. 1986).

dren's books is limited, or that extension of trade dress protection to PIL's book designs would restrict Landoll's ability to produce alternative competitive designs, nor did the district court so find. In fact, the evidence of record shows the design possibilities for such books are virtually infinite. Since no other cookbook or children's book has ever used the combination of features found in PIL's books until Landoll began copying them, it is impossible to conclude that the design of those books is functional. It is contrary to the purposes of the Lanham Act to limit protection to those designs of articles only where the design was useless and wholly unrelated to the function of the article. The court below lost track of the fundamental question in all trade dress cases: is the design sought to be protected essential to effective competition? Can others compete with PIL in the cookbook and children's book field without copying the specific design of its books or not? If they can, PIL's trade dress is not functional. *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332 (C.C.P.A. 1982).

The Court of Appeals found Plaintiff's trade dress to be functional because the padded covers and gilded covers made the books more desirable and "deluxe" looking, thereby becoming aesthetically functional. (Appendix, 8) This is absolutely not the test of functionality. The Court ignored its own prior holdings in reaching this conclusion. In *Schwinn Bicycle Co. v. Ross Bicycles, Inc.*, 870 F.2d 1176 (7th Cir. 1989) functionality was described as a design or feature which is superior in terms of manufacture, accommodation or utilitarian function or performance. A feature is functional only "if it is one that is costly to design around or do without rather than one that is costly to have." It

has long been held that even though individual elements may be functional, when grouped together the aggregate may be protected trade dress. *Hartford House, Ltd. v. Hallmark Cards, Inc.*, 846 F.2d 1268, 1272 (10th Cir. 1988), cert. denied, 488 U.S. 908, 109 S.Ct. 260, 102 L.Ed.2d 248 (1988). Upon what possible basis can it be held that a distinctive trade dress loses all protection because it is "aesthetically pleasing?" Injecting such a nebulous concept into an already confused area insures a reign of chaos. Where millions of dollars are at stake, such an unfocused, result-oriented approach simply cannot be tolerated.

The attractiveness of a product's design does not make it functional. The question is: Can others effectively compete without the same design? In determining whether a product feature is functional, a court may consider a number of factors including the availability of alternative designs and whether a particular design results from a comparatively simple or cheap method of manufacture. If there are commercially feasible alternative configurations which actually exist, then it is not functional. *Sega Enterprises, Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1513 (9th Cir. 1992). The court below did not acknowledge, or seem to realize the import of these decisions.

Several decisions have held the fact that a feature or combination of features makes the product aesthetically appealing does not transform a distinctive trade dress into a functional design. While aesthetic appeal may in some circumstances become functional, such as on apparel or jewelry, the real question is whether alternative appealing designs or presentations of the product

can be developed. *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513, 519 (10th Cir. 1987). In *Vuitton et Fils S.A. v. J. Young Enterprises, Inc.*, 644 F.2d 769, 773 (9th Cir. 1981) the court explicitly rejected an interpretation that would define any feature of a product that contributes to its consumer appeal and marketability as a functional element as a matter of law. The question is whether protection of the trade dress will hinder competition. A product feature is functional and not entitled to trade dress protection only if "exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage." *Disc Golf Ass'n v. Champion Discs, Inc.*, 158 F.3d 1002 (9th Cir. 1998). There is not one iota of evidence in this case that competition will be hindered if others cannot slavishly copy PIL's configuration for their cookbooks and children's books.

The resurrection of the aesthetic functionality concept as applied to PIL's books by the court below conflicts with the holdings of a majority of the circuits, which have mandated that to be functional, a product feature must have a significant relation to the utilitarian function of the product. *American Greetings Corp. v. Dan-Dee Imports, Inc.*, 807 F.2d 1136, 1142 (3rd Cir. 1986). It would be directly contrary to the purposes of the Lanham Act to deny one protection for its trade dress because it was more pleasing or attractive than its competitors'. As this Court has recognized, something is functional if "it is essential to the use of or purpose of the article or it affects the cost or quality of the article." *Inwood Laboratories, Inc. v. Ives Laboratories,* 456 U.S. 844, 102 S.Ct. 2182, 72 L.Ed.2d 606 (1982). The ruling below in this case conflicts with the long-held

view that the arbitrary combination of functional features is not functional. The ultimate inquiry, of which the court below lost track, is whether characterizing a feature or configuration as protected will hinder competition or impinge upon the rights of others to compete effectively in the sale of goods. *Sunbeam Products Inc. v. West Bend Co.*, 123 F.3d 246 (5th Cir. 1997), cert. denied, 118 S.Ct. 1795, 140 L.Ed.2d 936 (1998); *WSM, Inc. v. Tennessee Sales Co.*, 709 F.2d 1084 (6th Cir. 1983). A decision which injects such confusion into the law of trade dress must not be allowed to stand.

CONCLUSION

This case implicates issues of the utmost public and commercial importance, involving untold millions of dollars. Manufacturers are entitled to know what rights they possess in designing trade dress for their products. Competitors are entitled to uniform, reasonable rules as to what features of their products may be protected from use by others, and what are in the public domain. In cases such as this which turn on public perception of products in a competitive environment, whether the seller of a product has a right to protect the configuration of that product from predatory copying should be decided by a jury, not judges. The state of the law in this area is so unsettled that vast confusion currently reigns. The time is ripe for this Court to consider these important issues to provide guidance to the courts and the public.

Wherefore, petitioner prays that this Court's Writ of Certiorari issue and that the judgment below be reversed with directions that the district court's grant of summary judgment be vacated and this cause remanded for trial by a jury.

Respectfully submitted,

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IN THE
UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

No. 98-1490

PUBLICATIONS INTERNATIONAL, LTD.,

Plaintiff-Appellant,

v.

LANDOLL, INC.,

Defendant-Appellee.

Appeal from the United States District Court
for the Northern District of Illinois, Eastern Division.
No. 96 C 5180—**David H. Coar**, *Judge.*

ARGUED NOVEMBER 5, 1998—DECIDED DECEMBER 16, 1998

Before POSNER, *Chief Judge*, and FLAUM and MANION, *Circuit Judges.*

POSNER, *Chief Judge.* Both parties, PIL and Landoll, are publishers of cookbooks and children's books. PIL, the plaintiff, contends that its books have a distinctive "trade dress" which Landoll has copied in violation of section 43(a)(1) of the Lanham Act, 15 U.S.C. § 1125(a)(1), and of parallel state statutes unnecessary to discuss separately. The district judge granted summary judgment for Landoll.

The term "trade dress" refers to the appearance of a product when that appearance is used to identify the producer. To function as an identifier, the appearance must be distinctive by reason of the shape or color or

texture or other visible or otherwise palpable feature of the product or its packaging. If it isn't distinctive, it won't be associated in the mind of the consumer with a specific producer. If it is distinctive, and if as a result it comes to identify the producer, the danger arises that the duplication of this appearance, this "trade dress," by a competing seller will confuse the consumer regarding the origin of the product; the consumer may think it the product of the producer whose trade dress was copied. Trade dress thus serves the same function as trademark, and is treated the same way by the Lanham Act and the cases interpreting it. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773 (1992); *Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc.*, 781 F.2d 604, 608 (7th Cir. 1986); 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 8:1, pp. 8-3 to 8-4 (4th ed. 1998).

The courts have struggled to articulate a standard for when a trade dress is sufficiently distinctive to be entitled to the prima facie protection of the Lanham Act. See, e.g., *Dunn v. Gull*, 990 F.2d 348, 351 (7th Cir. 1993); *Insty*Bit, Inc. v. Poly-Tech Industries, Inc.*, 95 F.3d 663, 672 (8th Cir. 1996); *Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd.*, 40 F.3d 1431, 1448-51 (3d Cir. 1994); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1008-09 (2d Cir. 1995); *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977). This struggle is mirrored in the district judge's opinion and in the briefs of the parties. But efforts to define intuitive concepts such as "distinctiveness" are often both futile and unnecessary. We use with perfect clarity many words that we can't define, such as "time," "number," "beauty," and "law." Everyone can recognize when a product has a "distinctive" appearance, without having been tutored in the meaning of "distinctiveness." But "beyond stating the principles to be applied there is little to be said except to compare the impression made by the two" trade dresses. *Joseph Schlitz Brewing Co. v. Houston Ice & Brewing Co.*, 250 U.S. 28, 30

(1919) (Holmes, J.). So let us consider what is at stake in the decision. On the one hand, a seller should be encouraged to make his products recognizable by consumers at a glance as *his* product and not that of another seller. This way the seller will be able to appropriate the benefits of making a product that consumers like, and so he will have an incentive to make a good product. Other sellers won't be able to free ride on his efforts by tricking the consumer into buying an inferior product from them in the belief that it is the product of the seller whom they have grounds to trust.

On the other hand, a seller should not be allowed to obtain in the name of trade dress a monopoly over the elements of a product's appearance that either are not associated with a particular producer or that have value to consumers that is independent of identification. In the lingo of unfair competition, elements of the latter type—elements whose value is not merely signification—are a product's "functional" features; they can be either utilitarian in the narrow sense of that word, or aesthetic. *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 164-65 (1995); *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277, 297-98 (7th Cir. 1998); *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 338-40, 343 (7th Cir. 1985). Wine is sold corked. The cork is a functional feature of the product, because it enables the wine to age properly; and so the first seller of wine could not claim that the cork was his trade dress. Mink coats are normally sold dyed. The dye does not make the coat any warmer, but it makes it more beautiful, and, once again, it could not be claimed as trade dress by the first furrier to have hit on the idea. Functional improvements may be patentable, or protected as trade secrets, but they cannot be appropriated in the name of trade dress even if they are distinctive.

It would be arbitrary as well as puritanical and even philistine to deny that one function of modern consumer packaging is to be beautiful, the motivation being some-

times a hope that the consumer will infer the quality of the product from the beauty of the package and sometimes a hope that the consumer will derive utility (and so be willing to pay more) from the packaging directly, as when a consumer displays a shapely bottle of champagne to his dinner guests. A producer cannot in the name of trade dress prevent his competitors from making their products as visually entrancing as his own. Ordinarily there is a sufficient variety of pleasing shapes, sizes, colors, and ornamentation to enable beauty without sacrificing differentiation. But if consumers derive a value from the fact that a product looks a certain way that is distinct from the value of knowing at a glance who made it, then it is a nonappropriable feature of the product.

So there cannot be an objection in principle to the concept of aesthetic functionality as a limitation on the legal protection of trade dress. And notice how the "utilitarian" and the "aesthetic" merge in the case put earlier of corking. The cork improves the taste of the wine; the dye enhances the beauty of the mink coat; taste is akin to beauty. But the critics who argue that in application the concept is mischievously vague certainly have a point, see, e.g., 1 McCarthy, *supra*, §§ 7:80, 7:81, though not one necessary to labor further here.

Formally, distinctiveness and functionality are separate issues. While the burden of proving distinctiveness is of course on the plaintiff, some courts, including our own, hold that functionality is an affirmative defense and so the burden of proof rests on the defendant. E.g., *Thomas & Betts Corp. v. Panduit Corp.*, *supra*, 138 F.3d at 297; *Knitwaves, Inc. v. Lollytogs Ltd.*, *supra*, 71 F.3d at 1006. Other courts place the burden on the plaintiff. E.g., *Versa Products Co. v. Bifold Co.*, 50 F.3d 189, 199 (3d Cir. 1995); *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 869 (8th Cir. 1994). Others have passed. E.g., *Tools USA & Equipment Co. v. Champ Frame Straightening, Inc.*, 87 F.3d 654, 657 n. 2 (4th Cir. 1996); *Tec Engineering Corp. v. Budget Molders*

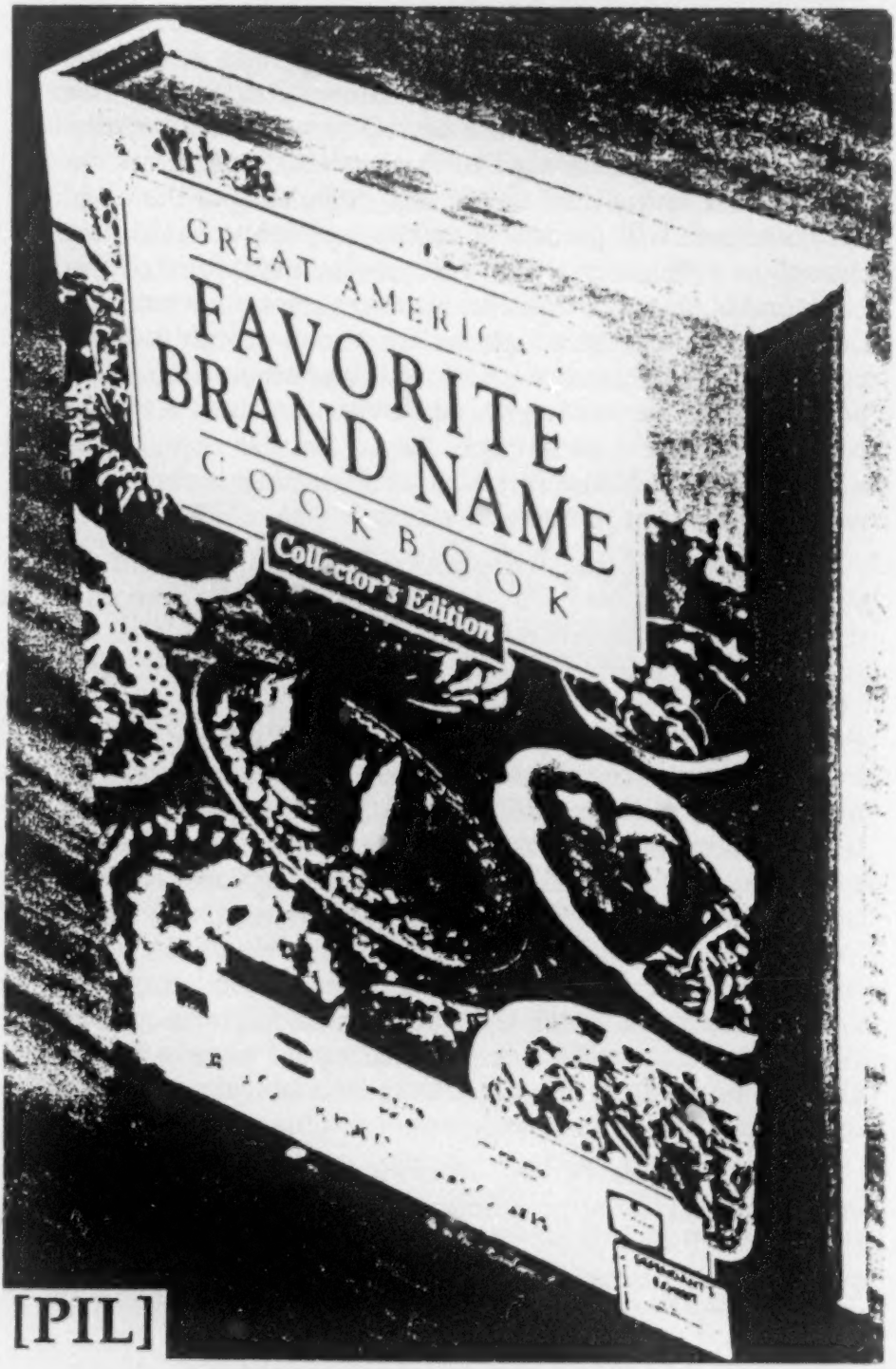
Supply, Inc., 82 F.3d 542, 546 n. 3 (1st Cir. 1996). The uncertainty is limited to unregistered trademarks or trade dress (PIL's trade dress is unregistered); registration creates a presumption of validity, implying that the defendant has the laboring oar on all issues relating to validity, including functionality, as held in *Aromatique, Inc. v. Gold Seal, Inc.*, *supra*, 28 F.3d at 869.

Very little turns on resolving the circuit conflict, both because evidence of functionality is equally available to both parties and because functionality and distinctiveness are intertwined issues. Functional features are by definition those likely to be shared by different producers of the same product and therefore are unlikely to identify a particular producer. The principal exception is for new products. If a product is truly new, its functional features may be new too and so may help distinguish it from other products and thus identify the producer. Nevertheless, these features cannot be appropriated; otherwise, competitors would be prevented from duplicating the new product even to the extent permitted by the branches of the law of intellectual property that protect innovation rather than designations of source. The first producer of an automobile designed a product that had a distinctive appearance; but if its distinctiveness was due to the fact that it had an engine in front instead of horses, and a crank, radiator grill, and steering wheel, the producer would not be able to claim that this combination of functional features constituted trade dress; for that would give him a monopoly of the production of automobiles, and trademark law is not intended to confer product monopolies. *W.T. Rogers Co. v. Keene*, *supra*, 778 F.2d at 339.

There isn't much more to be said at the level of doctrine about the issue in this case, except that a grant of summary judgment on the basis either that the plaintiff's trade dress is not distinctive or that its distinctiveness rests on functional features of the dress is proper only if no reasonable trier of fact could conclude otherwise. See,

e.g., *Thomas & Betts Corp. v. Panduit Corp., supra,* 138 F.3d at 297-300; *Sands, Taylor & Wood Co. v. Quaker Oats Co.,* 978 F.2d 947, 952 (7th Cir. 1992); *OddzOn Products, Inc. v. Just Toys, Inc.,* 122 F.3d 1396, 1408 (Fed. Cir. 1997). For while it is true that distinctiveness is not really an issue of fact, but rather an issue of the application of a legal standard to facts, it is classified with issues of fact for purposes of drawing the line between the jury's authority and that of the judge and the reviewing court. *Disc Golf Ass'n, Inc. v. Champion Discs, Inc.,* 158 F.3d 1002, 1006 (9th Cir. 1998); *Pebble Beach Co. v. Tour 181 Ltd.,* 155 F.3d 526, 537 (5th Cir. 1998); *Fun-Damental Too, Ltd. v. Gemmy Industries Corp.,* 111 F.3d 993, 1001-02 (2d Cir. 1997); *Epic Metals Corp. v. Souliere,* 99 F.3d 1034, 1037 (11th Cir. 1996); cf. *Mucha v. King,* 792 F.2d 602, 604-06 (7th Cir. 1986).

The trade dress of PIL's cookbooks is illustrated in the photograph (unfortunately not in color) that we have captioned "PIL." The components of the trade dress are the size of the pages (8½ inches by 11 inches), the gilded edges of the pages, and the covers, which are oilcloth or the equivalent. Each of these features is functional. The size of the pages is a convenience to the cook, who will usually want to lay the book flat on the kitchen counter (and that's easier to do if the book is large) and glance at it while cooking, which is easier to do if the print is large—and the larger the print, the larger the page must be if the total number of pages is not to be excessive. When the book is open, moreover, the recipe is on one page and a photograph of the dish that faithful compliance with the recipe is supposed to produce occupies the entire facing page. The larger the page and so the larger the picture, the more inviting the dish looks and so the more likely the reader is to try the recipe. The oilcloth cover makes it easier to keep the book clean, which is an issue with


GREAT AMERIC
FAVORITE
BRAND NAME
COOKBOOK
Collector's Edition

[PIL]

cookbooks because they are quite likely to get spattered in the course of cooking. And the gilded pages are necessary to prevent the unsightly appearance that printers call "bleeding." If a color picture on a page runs all the way to the page's edge, then when the book is closed, the side opposite the spine (that is, the side consisting of the ends of the pages) will present a motley appearance. Gilding the edges eliminates the differences in the colors of the page ends. Aesthetic considerations are not alien to book design. Although the adage is that you shouldn't judge a book by its cover, many people do this; otherwise, many books would be sold without covers, as used to be a common practice in Europe. Some people buy books mainly as wall decoration, and bookbinding is regarded as an art and not just as a trade.

What is true is that the problem of bleeding could be solved by giving the ends of the pages any uniform color; it needn't be gold. But the color gold on a product or its package is a prime example of aesthetic functionality. This is the case mentioned in *Qualitex Co. v. Jacobson Products Co, supra*, 514 U.S. at 165, where "color plays an important role (unrelated to source identification) in making a product more desirable." Gold connotes opulence, and so is a standard element of the décor of food products, such as chocolate, that are valued for their rich taste rather than for their nutritional value. It also has a long history of use in bookbinding; the spine of the book in which this opinion is printed is decorated with gilt. Gold is a natural color to use on a fancy cookbook. A different color on PIL's page ends would have a better claim to be a source signifier; compare a blue container of orange juice with an orange one.

Although none of the functional features of PIL's cookbooks can be appropriated to serve as a trade dress, it doesn't follow that the ensemble cannot be. Any product, any package, can be decomposed into elements

that are not protectable. *August Storck K.G. v. Nabisco, Inc.*, 59 F.3d 616, 620 (7th Cir. 1995). Every distinctive appearance is built up from elements that are not themselves distinctive: an Aubrey Beardsley drawing, for example, is built up of line segments. Cf. *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 936 (7th Cir. 1989). In the case of a consumer product, the elements might all be functional. If the product nevertheless presented a distinctive appearance, that appearance would be eligible for legal protection as trade dress unless it was the only way the product *could* look, consistent with its performing each of the product's functions optimally. E.g., *Service Ideas Inc. v. Traex Corp.*, 846 F.2d 1118, 1123 (7th Cir. 1988); *Fuddruckers, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 842 (9th Cir. 1987); *American Greetings Corp. v. Dan-Dee Imports, Inc.*, 807 F.2d 1136, 1143 (3d Cir. 1986); *LeSportsac, Inc. v. K-Mart Corp.*, 754 F.2d 71, 76-78 (2d Cir. 1985). But obviously the fact that a competitor's product has the same functional features as the plaintiff's isn't going to make the latter distinctive; if it didn't have the same functional features, it might not be the same product.

Every producer of a cookbook has to worry about the cover getting spattered, the cook having difficulty laying the book flat and reading small print from a distance, the photos of the food dishes being too small to entice and inspire, the book as a whole looking cheap, and the pages (when the book is viewed from the side opposite the spine) presenting a ragged appearance because the color pictures that fill them bleed to the end of the page. Because of these concerns that are common to all publishers of fancy cookbooks, it is not surprising that more than one publisher would find it optimal, wholly apart from any desire to confuse consumers about the publisher's identity, to use the very combination of features that PIL claims compose its trade dress—large pages, an oilcloth cover, gilded page edges. Cookbooks published by different publishers will look rather alike in much the same

way that automobiles produced by different automobile manufacturers look rather alike, or like many paperback books designed for the airport trade look rather alike because they have the same page dimensions and the same style of cover—laminated paper with the name of book and author in raised letters. Unabridged dictionaries, board-page books for infants, travel books, encyclopedias, atlases, law books, and comic books are other examples of book genres that contain innumerable look-alikes published by different publishers, look-alikes that do not, however, confuse consumers about the identity of the publisher of any particular book.

We don't wish to seem wise after the event; someone had to be the first to think up the combination of oilcloth cover, large pages, and gilded edges, and for all we know that was PIL. But to reiterate the theme of this opinion, trademark and trade dress law do not protect originality; they protect signifiers of source. Publishers who want to distinguish their look-alikes from their competitors'—who want, that is, to make their trade dress identify the publisher—can easily do so by adopting a distinctive logo, imposing a uniform design, typeface, or color on the covers of their books, printing their name prominently on the covers, or doing all these things, as Penguin does. PIL does none of these things. It's its own fault if someone casually picking up a cookbook published by PIL and a cookbook published by Landoll thinks they were published by the same company; but it is more likely that the consumer would merely think the two books the same *type* of cookbook.

We have said nothing as yet about PIL's children's books. They are similar to the cookbooks, except that the pages are smaller (8½ by 8½) and the books shorter. The pages have gilded edges and the covers an oilcloth feel. But all three features (page size, gilding, and cover texture) are functional for children's books as for cookbooks. Children need large print, hence large pages, and they

like large pictures more than small ones (and large pictures require large pages); in some children's books the color pictures would bleed to the margin if the ends of the pages weren't uniformly colored; children frequently have dirty hands that stain everything they touch; and children love gold. PIL's children's books look like generic children's books rather than like the books of a particular publisher. They do not have a uniform series title (like "Golden Books"), the covers do not have uniform colors or designs, and the publisher's name is not prominently displayed. They are no more distinctive than the cookbooks.

Because the district judge found, correctly in our judgment, that PIL's books are not distinctive, he didn't reach the question whether Landoll's books are so similar as to be likely to confuse consumers. But as the ultimate issue in a trademark or trade dress case is likelihood of confusion, we were struck by PIL's failure to include in its appendix to either its main brief in this court, or its reply brief, photographs either of any of its own books or any of the books of Landoll that it claims are infringing its trade dress. In intellectual property cases, a picture, or, better, the very object claimed to infringe, is worth a thousand words of brief. Because Landoll's books resemble PIL's quite closely, as shown in the next photograph, PIL might have gotten some forensic mileage out of showing us the publishers' books juxtaposed. But the resemblance is generic, rather than specific. PIL's trade dress is not distinctive enough that its look-alikes would fool consumers.

AFFIRMED.

America's Best
C·O·O·K·I·N·G
[Landoll]

45 U.S.P.Q.2d 1277
(Cite as: 1997 WL 769349 (N.D.Ill.))

PUBLICATIONS INTERNATIONAL, LTD.,
an Illinois corporation, Plaintiff,

v.

LANDOLL, INC., an Ohio corporation, Defendant.

No. 96 C 5180.

United States District Court, N.D. Illinois.

Dec. 5, 1997.

MEMORANDUM OPINION AND ORDER

COAR, District J.

*1 Before the court is defendant Landoll, Inc.'s ("Landoll" or "defendant") motion for summary judgment of noninfringement as to all counts of plaintiff Publications International, Ltd.'s ("PIL" or "plaintiff") complaint, which alleges trade dress infringement of plaintiff's books under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), unfair methods of competition and unfair or deceptive acts or practices under the Illinois Consumer Fraud and Deceptive Business Practices Act, 815 ILCS 505/2, and deceptive trade practices under the Illinois Uniform Deceptive Trade Act, 815 ILCS 510/2(8). For the reasons set forth in this memorandum opinion, the defendant's motion is GRANTED and judgment is entered for the defendant on count one.

I. Facts

Can you judge a book by its cover? Plaintiff PIL says that you can—where that cover is glossy and padded,

on a cookbook or children's book with gold-colored, gilded pages and of a certain length, you can (and will) judge that that book is a PIL book. Once upon a time (1993), in the State of Illinois, PIL, a publisher offering books in several different areas, first began to sell cookbooks with certain characteristics: a uniform trim size of 8.5" by 11"; a length of 608 pages with gilded, gold-colored edges; glossy, padded covers; and printed in four colors. (Dft's 12(M) Stmt. ¶¶ 42, 9; Ptf's 12(N) Stmt., ¶ 1, 9.) PIL's cookbooks sold well, selling 2,702,171 copies of various cookbooks from 1993 to February 17, 1997. (Dft's 12(M) Stmt. ¶ 46.) In 1994, PIL began to sell children's books with certain characteristics: titles beginning "Treasury of . . ."; a uniform trim size of 9" by 9"; a length of 384 pages with gilded, gold-colored edges; glossy, padded covers; and printed in four colors. (Dft's 12(M) Stmt. ¶¶ 43, 10.) From 1994 to February 17, 1997, PIL sold 2,323,232 children's books, all incorporating these same characteristics. (Dft's 12(M) Stmt. ¶ 47.) All in all, PIL has published 17 different books (8 cookbooks and 9 children's books) incorporating the alleged trade dress. (Dft's 12(M) Stmt. ¶ 45.)

Gilded pages are readily available to all publishers through such printers as R.R. Donnelly & Sons ("Donnelly"), the printer for both PIL and Landoll. (Dft's 12(M) Stmt. ¶ 16.) Gilded pages can serve a number of purposes for books: masking a "bleed," where pictures and photographs which extend to the edges of a page present an uneven and unattractive series of different colored stripes on the edges; adding to the quality, aesthetic appeal, and attractiveness of books; creating a more deluxe, upscale, and ornamental book; increas-

ing the price-point of a book; adding to the perceived value of a book; and contributing to the commercial success of books. (Dft's 12(M) Stmt. ¶¶ 19, 24-27.) Padded covers are readily available to all publishers through printers, such as Donnelly, and have been used by publishers since at least 1986 or 1987. (Dft's 12(M) Stmt. ¶ 20.) Padded covers can serve a number of purposes for books: adding to the quality, aesthetic appeal, and attractiveness of books; creating a more deluxe, upscale, and ornamental book; increasing the price-point of a book; adding to the perceived value of a book; and contributing to the commercial success of books. (Dft's 12(M) Stmt. ¶¶ 24-27.) Third party publishers use gilded pages; third party publishers also use padded covers in a variety of markets. (Dft's 12(M) Stmt. ¶¶ 18, 22.) Some third party publishers use the combination of gilded pages and padded covers on their books but, for purposes of this motion, Landoll admits that it knows of no third party publishers using that combination with cookbooks or children's books. (Dft's 12(M) Stmt. ¶ 28; Dft's 12(M) Reply ¶ 28.) Donnelly salesman Jack Field has stated that gilded pages and padded covers tend to be used in "predominantly the same types of markets," i.e., where aesthetics were important for selling books. (Dft's 12(M) Stmt. ¶ 28.) Trim size tends to be depend in part on the size of the film to be included in the book, and the trim size used by PIL for its cookbooks, 8.5" by 11", is a common size for books and is economical and cost-effective. (Dft's 12(M) Stmt. ¶¶ 29-30, 33.) Cost and the ultimate price-point for a book are related to the trim size used. (Dft's 12(M) Stmt. ¶ 32.) Similarly, the number of pages contained in a book affects the perceived value of the book

by the consumer. (Dft's 12(M) ¶ 35.) Four color printing is a common practice in publishing. (Dft's 12(M) ¶ 36.) "Treasury of . . ." is a term which is a "consumer friendly" way of saying either compilation or treasury within one book. (Dft's 12(M) ¶ 37.) The term "treasury of . . ." is part of the title or subtitle on at least 346 different books published in the United States or exclusively distributed in the United States and which are currently or soon to be available in the near future. (Dft's 12(M) ¶ 38.) As Donnelly salesman Field has stated, the features alleged as trade dress by PIL "can be used in any number of combinations and it's really dictated by the publisher." Other features which could be used to increase attractiveness or appeal of books include ribbon markers, onlay, foil stamping, or a leather cover. (Dft's 12(M) ¶¶ 39-40.)

*2 One means of selling PIL's cookbooks and children's books was through display marketing, which is a marketing technique where products are marketed to ultimate consumers by being left at locations, such as schools or businesses, for several days to allow employees to inspect and then order the merchandise. (Dft's 12(M) Stmt. § G, especially ¶ 55.) Cookbooks and children's books are particularly well suited to be sold through display marketing, and books which have a higher perceived value, through such features as a padded cover, glossiness, gilded pages, and a heavier weight of the book, are quite appropriate for display marketing. (Dft's 12(M) Stmt. ¶¶ 57-58.) Thus, cookbooks with padded covers and gilded pages are successfully sold through display marketing. In fact, cookbooks sold through display marketing without padded covers or gilded pages have a lower price point and sell "'[n]ot

nearly as well'" as books having padded covers and gilded pages. (Dft's 12(M) Stmt. ¶ 56, 60.) In short, to sell cookbooks at the higher price point of $20 to $25, a company must provide a product with features, such as "'padding, gilding, and high page count'" which indicate higher value. (Dft's 12(M) Stmt. ¶ 61.)

In 1992, the owner of PIL, Louis Weber ("Weber") formed his own display marketing company; in fall 1994, PIL ceased selling all book products, including the subject books with padded covers and gilded pages, to third party display marketing companies in the United States. (Dft's 12(M) Stmt. ¶¶ 62-64.) Two reasons given by PIL executives for this decision are that PIL sought to use Weber's company as its "distributor of choice" in display marketing areas and that PIL did not want to "fund[ ] the competition." (Dft's 12(M) Stmt. ¶ 65.)

This lawsuit has occurred because of what happened next in the story. Certain customers, including display marketing companies, informed Landoll that they wanted books having features which made books more expensive-looking and increased the books' value or the perceived value. (Dft's 12(M) ¶ 14.) Landoll, seeking to "go more upscale" and enter into different, higher price-point markets, began to publish cookbooks and children's books using PIL's alleged trade dress: namely, cookbooks which are 8.5" by 11", contain varying numbers of pages[1] with gold-colored gilded pages, with

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[1] The two parties dispute the similarity in the number of pages in Landoll's books as compared to the (uniform) number of pages in PIL's books. For the purposes of this motion, which

(continued...)

glossy, padded covers, and printed in four colors and children's books which are 9" by 9", containing varying numbers of pages with gold-colored gilded edges, with glossy, padded covers, with subtitles utilizing the term "Treasury of . . .", and printed in four colors. (Dft's 12(M) ¶¶ 11-13.) Landoll first began to publish books with these combinations of features in 1995. (Dft's 12(M) ¶ 44.)[2]

II. Summary judgment standards

Summary judgment is proper "if the pleadings, depositions, answers to interrogatories and admissions on file, together with the affidavits, if any, show that there

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[1] (...continued)
deals with the distinctiveness of the alleged trade dress rather than the likelihood of confusion between Landoll's and PIL's books, the court notes merely that the books are of similar lengths.

[2] The parties include a number of facts which ultimately are not material to this particular motion, including facts put forward by Landoll regarding the lack of secondary meaning for the alleged trade dress and facts put forward by PIL regarding the intent of the two parties and regarding the likelihood of confusion. PIL does not argue that its trade dress has achieved secondary meaning but states that PIL "need not prove secondary meaning." (Ptf's Response, p. 13-14.) As discussed below in this opinion, the intent of the parties is not relevant; under the Lanham Act, Landoll is free to raid a non-distinctive trade dress without secondary meaning, and PIL's alleged intent to create a unique trade dress does not make a non-distinctive trade dress inherently distinctive. Finally, the likelihood of confusion is not at issue in this motion; Landoll's motion sought summary judgment solely on the issues of distinctiveness and functionality of the alleged trade dress—not on the likelihood of confusion.

is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed.R.Civ.P. 56(c); Cox v. Acme Health Serv., Inc., 55 F.3d 1304, 1308 (7th Cir.1995). A genuine issue of material fact exists for trial when, in viewing the record and all reasonable inferences drawn from it in a light most favorable to the non-movant, a reasonable jury could return a verdict for the non-movant. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248, 106 S.Ct. 2505, 2510, 91 L.Ed.2d 202 (1986); Hedberg v. Indiana Bell Tel. Co., 47 F.3d 928, 931 (7th Cir.1995). The movant has the burden of establishing that there is no genuine issue of material fact. Celotex Corp. v. Catrett, 477 U.S. 317, 323, 106 S.Ct. 2548, 2553, 91 L.Ed.2d 202 (1986); Hedberg v. Indiana Bell Tel. Co., 47 F.3d 928, 931 (7th Cir.1995). If the movant meets this burden, the non-movant must set forth specific facts that demonstrate the existence of a genuine issue for trial. Fed.R.Civ.P. 56(e); Celotex, 477 U.S. at 324, 106 S.Ct. at 2553. Rule 56(c) mandates the entry of summary judgment against a party "who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and in which that party will bear the burden of proof at trial." Celotex, 477 U.S. at 322, 106 S.Ct. at 2552-53. As a general rule, a scintilla of evidence in support of the non-movant's position is not sufficient to oppose successfully a summary judgment motion; "there must be evidence on which the jury could reasonably find for the [non-movant]." Anderson, 477 U.S. at 250, 106 S.Ct. at 2511.

III. Lanham Act Analysis

*3 This case involves a relatively new question in trade dress: trade dress protection of product configuration. The parties failed to come to grips with—or even to acknowledge—the body of law dealing with the specific question, as opposed to the body of law dealing with general trade dress issues. While the general cases are not irrelevant to the issue at hand, they are not helpful in answering the question of whether PIL's product configuration merits protection as inherently distinctive trade dress. As this section demonstrates, PIL's product configuration does not merit such protection.

Trade dress "encompasses the overall appearance of a product including its size, color or color combinations, texture graphics, packaging or other visual features." Roulo v. Russ Berrie & Co., Inc., 886 F.2d 931, 936 (7th Cir.1989), cert. denied, 493 U.S. 1075, 110 S.Ct. 1124, 107 L.Ed.2d 1030 (1990). "An infringement of the trade dress is proven if: (1) the plaintiff's trade dress is inherently distinctive or has acquired secondary meaning, (2) the plaintiff's trade dress is primarily non-functional, and (3) the defendant's trade dress is confusingly similar, engendering a likelihood of confusion in the marketplace." Id. at 935. The plaintiff has the burden of proof to show that prongs one and three are met, while the defendant has the burden of proof to show that prong two has not been met (i.e., that the trade dress is primarily functional). Computer Care v. Service Systems Enterprises, Inc., 982 F.2d 1063, 1067-68 (7th Cir.1992). In this motion, Landoll argues that PIL has failed to meet its burden of proof on prong 1 and that Landoll has met its burden of proof on prong three.

PIL seeks to meet its burden on prong one by showing that its trade dress is inherently distinctive. PIL is correct when it states that it need not show secondary meaning in the market, that consumers actually link the product with PIL, for proof that a product's trade dress is distinctive is sufficient in and of itself, where PIL successfully shows that the trade dress is inherently distinctive. Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 773, 112 S.Ct. 2753, 2760, 120 L.Ed.2d 615 (1992); Roulo, 886 F.2d at 937; Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc., 781 F.2d 604, 608 (7th Cir.1986); Chevron Chemical Co. v. Voluntary Purchasing Group, 659 F.2d 695, 702 (5th Cir.1981). But what PIL seeks to protect as inherently distinctive trade dress is its product configuration: the various parts that make up a book: cover, pages, trim size, heft, and, with the children's books, the term "Treasury of . . ." in the title. As the Seventh Circuit has stated, "[t]rade dress protection in the configuration of the product itself opens up another can of worms." Thomas & Betts Corp. v. Panduit Corp., 65 F.3d 654, 657 (7th Cir.1995), cert. denied, ___ U.S. ___, 116 S.Ct. 1044, 134 L.Ed.2d 191 (1996). Trade dress is only protected insofar as the trade dress serves as a "signifier of source"; where the "trade dress" at issue is a product configuration, there is a risk that protecting the trade dress will prevent competitors "from duplicating features whose value to consumers is intrinsic and not exclusively as a signifier of source," thus injuring competition and preventing copying which is beneficial to consumers. Id. at 657. In short, a court considering a trade dress infringement action dealing with product configuration must consider "whether a product feature's primary significance to

consumers is as an identifier of source or as an element which contributes to the inherent appeal of the product." Id. at 658.

*4 The question remains: what standard to apply to determine whether a product configuration is inherently distinctive? One possibility is to use the so-called Abercrombie taxonomy of marks, which categorizes marks in "categories of generally increasing distinctiveness . . . (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful." Taco Cabana, 505 U.S. at 768, 112 S.Ct. at 2757 (citing Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2nd Cir.1976). PIL argues that this taxonomy should apply to its trade dress and, moreover, argues that because the design of the books is "only tenuously connected with the nature of the content of those books," that design is arbitrary or fanciful or, at most, suggestive. (Ptf's Resp. at 5.) This argument misses the point. The design of the books is part of the books—not something that is in relation to the books. See Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd., 40 F.3d 1431, 1440-41 (3rd Cir.1994) ("[A] product configuration differs fundamentally from a product's trademark, insofar as it is not a symbol according to which one can relate the signifier (the trademark, or perhaps the packaging) to the signified (the product). Being constitutive of the product itself and thus having no such dialectical relationship to the product, the product's configuration cannot be said to be 'suggestive' or 'descriptive' of the product, or 'arbitrary' or 'fanciful' in relation to it."). See also Thomas & Betts, 65 F.3d at 658 ("The issue is slightly different in most trade dress product configuration cases, because product features, though they may iden-

tify the source of the product, do not really identify the product—they are the product.") (citing Duraco); Knitwaves, Inc. v. Lollytogs Ltd. (Inc.), 71 F.3d 996, 1007-08 (2nd Cir.1995) (rejecting application of Abercrombie taxonomy to product configuration; stating that the classification of marks into 'generic,' 'descriptive,' 'suggestive,' or 'arbitrary or fanciful' make[s] little sense when applied to product features"; stating that "'arbitrary,' 'fanciful,' or 'suggestive' packaging of a product may be presumed to serve this source-identifying function" but that "the same presumption may not be made with regard to product features or designs whose primary purposes are likely to be functional or aesthetic."); Sassafras Enterprises, Inc. v. Roshco, Inc., 915 F.Supp. 1, 4 n. 4 (N.D.Ill.1996) (stating that the Abercrombie "taxonomy really does not help much when the appearance of the product itself is at issue").[3] But see Stuart Hall Co., Inc. v. Ampad Corp., 51 F.3d 780, 788 (8th Cir.1995) (rejecting distinction between product configuration and product packaging; rejecting Duraco reasoning or test).

Beyond the irrelevance of the Abercrombie taxonomy of distinctiveness as applied to product configuration, application of the Abercrombie taxonomy to product features runs the risk of providing trade dress protection into the indefinite future for features which, while unique to the product at issue, are not source-identi-

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[3] Cf. University of Georgia Athletic Assoc. v. Laite, which clearly demonstrates that the Abercrombie taxonomy is used to show a relationship between a mark (there, the "University of Georgia" mascot) and the product (there, the University of Georgia athletic teams). 756 F.2d 1535, 1540-41 & n. 16 (11th Cir.1985).

fying. Here, PIL argues that because the books' features "convey nothing about the contents" of the books and asserts (without support) that "[v]irtually no one purchases a book simply because it looks good on the outside. If the contents do not deliver, there will be no sale, unless, of course, the consumer believes it to be a book published by a publisher with whose trade dress he or she has become familiar, and with whose products he or she has been satisfied in the past."[4] (Ptf's Resp. at 5.) But this argument shows the inherent danger of applying the Abercrombie taxonomy to product configuration. The undisputed facts show that the alleged

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[4] PIL also errs in this statement by confusing and melding the "inherently distinctive" test and the "secondary meaning" test. "To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself." Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844, 851 n. 11, 102 S.Ct. 2182, 2187 n. 11, 72 L.Ed.2d 606 (1982). See also Qualitex Co. v. Jacobson Products Co., Inc., 514 U.S. 159, 164, 115 S.Ct. 1300, 1303, 131 L.Ed.2d 248 (1995) (citing Inwood Labs definition of "secondary meaning"); Thomas & Betts, 65 F.3d at 658 (same); Sassafras Enterprises, Inc. v. Roshco, Inc., 915 F.Supp. 1, 6 (N.D.Ill.1996) (same). Thus, PIL's argument regarding whether a consumer buys its books because they look and feel good or because he or she associates them with "a publisher [i.e., PIL] with those trade dress he or she has become familiar", (Ptf's Resp. at 5 (emph.added)), goes to the question not of whether the trade dress is inherently distinctive but whether the product's features have acquired secondary meaning in the minds of the public, i.e., that consumers seek to purchase the product not for its "inherent appeal" but because they "desire the product with the particular feature because it signifies that producer." Thomas & Betts, 65 F.3d 658-59 (discussing secondary meaning in product configuration case). PIL has offered neither evidence nor argument supporting such a secondary meaning claim.

trade dress at issue is made up entirely of features which contribute to the price-point, salability, and aesthetics of the books, but, under PIL's view of the trade dress world, the fact that PIL did not have to use those features and was the first to decide that the particular combination of features would be an effective way of selling books means that PIL should presumptively have perpetual protection of that combination. That is simply not the case.[5]

*5 If the Abercrombie taxonomy does not apply to product configuration cases, what is the applicable standard? There are several options. The first, the Chevron test, states that a trade dress is inherently distinctive "[i]f the features of the trade dress sought to be protected are arbitrary and serve no function either to describe the product or assist in its effective packaging." 659 F.2d at 702. As stated in this court's opinion in Nelson/Weather-Rite Inc. v. Leatherman Tool Group, Inc., 1995 WL 669091, *8 (N.D.Ill.1995), and in accordance with the discussion above regarding the Abercrombie taxonomy, the court finds that the Chevron test is inapplicable when dealing with product configuration as opposed to the "packaging" of a product. The second option is the Seabrook Foods, Inc. v. Bar-Well Foods, Ltd. test which requires a determination of: (1) whether a trade dress is a common, basic shape or design; (2) whether it is unique or unusual in its particular field; (3) whether it is a mere refinement of a com-

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[5] This holding does not contradict Taco Cabana, as PIL suggests in its Response. Taco Cabana operated under the assumption that Taco Cabana's trade dress was not descriptive, was inherently distinctive, and was not functional. 505 U.S. at 770, 112 S.Ct. at 2758.

monly-adopted and well-known form of ornamentation for a particular class of goods which consumers view as mere ornamentation. 568 F.2d 1342, 1344 (C.C.P.A. 1977). "In reality, all three questions are merely different ways to ask whether the design, shape or combination of elements is so unique, unusual or unexpected in this market that one can assume without proof that it will automatically be perceived by customers as an indicator of origin—a trademark." 1 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 8.13 (4th ed.1997). The McCarthy restatement of the Seabrook test has been cited by two recent cases in this district as the appropriate overall principle by which to judge inherent distinctiveness in product configuration trade dress cases. See Artipresent GmbH Vertrieb Internationaler Collectionen fur den Wohnbereich v. Emruss Corp., 1997 WL 534358, *2 (N.D.Ill.1997); Sassafras, 915 F.Supp. at 5 (using McCarthy restatement of the Seabrook test as the standard by which to judge the inherent distinctiveness of a trade dress in a product configuration case). This is the approach which this court will apply.[6]

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[6] The court in Thomas & Betts cited with approval the Third Circuit's discussion in Duraco of inherent distinctiveness in product configuration case. 65 F.3d at 658 n. 3. In Duraco, the Third Circuit, in addition to discussing the complexities and special context of product configuration cases, adopted a three-element test for inherent distinctiveness in product configuration cases: to be inherently distinctive, and thus protected as trade dress without need to show secondary meaning, a product configuration must be "(i) unusual and memorable; (ii) conceptually separable from the product; and (iii) likely to serve primarily as a designator of the product." 40 F.3d at 1448. The Second Circuit has accepted Duraco's discussion of the context

(continued...)

In applying the Seabrook/Sassafras test to PIL's alleged trade dress, the court finds that PIL's alleged trade dress is not sufficiently "unique, unusual or unexpected" in the book market to "automatically be perceived . . . as an indicator of origin" because it is merely a refinement of existing ornamentation. Here, every element in the alleged trade dress serves a function—namely, of making the overall product more desirable to consumers as a "deluxe" product and, thus, enabling the same of the overall product with a higher price-point. No Seventh Circuit case has ever held that a product configuration consisting completely of functional elements can be inherently distinctive. Cf. Elmer v. Ice Fabricating, Inc., 67 F.3d 1571, 1579-80 (Fed.Cir. 1995) (noting that, while the Eleventh Circuit may find that a product including some functional features is inherently distinctive, "the Eleventh Circuit has not held protectable a trade dress that encompassed only useful product features"). Additionally, every element included in the product configuration is common to the book industry—and, thus, even though it puts together these elements in a "new" combination, the trade dress overall is not unique. See Turtle Wax, Inc. v. First Brands Corp., 781 F.Supp. 1314, 1320-21 (refusing to find inherent distinctiveness in "new" combination of

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[6] (...continued)
of product configuration cases while reject the first two elements of Duraco's test as "not rooted in the language of the Lanham Act." Knitwaves, 71 F.3d at 1008 & n. 6. The court in this case does not need to determine whether the test for inherent distinctiveness in product configuration cases should include the first two Duraco elements because PIL has failed to meet the third element, which is essentially the same as the Seabrook/Sassafras test.

elements where "no single component of the . . . trade dress . . . truly is unique to that product"; "The Court cannot agree with Turtle Wax that a finding of inherent distinctiveness was required simply because no existing product utilized precisely the same combination of elements as plaintiff's . . . trade dress."). In a market where these elements are used by third party publishers to create a higher perceived value for their books, there is no reason to believe that consumers should perceive the particular combination of elements as anything more than a refinement of ornamentation raising the perceived value of the books.

*6 PIL points to several cases where product lines were deemed inherently distinctive. None are analogous. The three relevant product lines discussed by PIL are greeting cards/stationery, furniture, and books. Of the three greeting cards/stationery cases, one, Hartford House, Inc. v. Hallmark Cards, Inc., involved a product line that the district court found "had acquired a secondary meaning"; the case does not discuss whether the cards could have been protected as inherently distinctive. 846 F.2d 1268, 1272 (10th Cir.), cert. denied, 488 U.S. 908, 109 S.Ct. 260, 102 L.Ed.2d 248 (1988). The second case, Roulo, involved a card design which a third-party card curator testified was so unique that to her knowledge no other card in that century had used it. 886 F.2d at 936. There was also testimony from the defendant that the plaintiff's cards "were as unusual as those of . . . other famous card designers." Id. The third case deals with product packaging using "bold colors and a graduated color fade with knock-out graphics and other artwork on the package"; the court found that the "unique use of colors and graphics creates a distinctive

visual impression in the minds of consumers." Lisa Frank, Inc. v. Impact International, Inc., 799 F.Supp. 980, 989 (D.Ariz.1992). Beyond the fact that these cases are dealing with the law pre-Taco Cabana, Duraco, and Thomas & Betts,[7] each case involves an item whose overall look was a distinct, artistic impression, and, thus, collectively do not dictate that a combination of features which "is merely a refinement of existing forms of ornamentation" should be protected by the Lanham Act. See Turtle Wax, 781 F.Supp. at 1321-22 (distinguishing Roulo). The second line of cases at issue involved furniture. The Federal Circuit in Imagineering, Inc. v. Van Klessens, Inc. upheld a jury's finding that a particular line of furniture was inherently distinctive where the plaintiffs had offered evidence of media accounts calling the furniture line "'novel,' 'exclusive,' and 'outdoor classics,' and testimony from witnesses that the line "was unlike any other furniture yet produced." 53 F.3d 1260, 1264 (Fed.Cir.1995), cert. denied, ___ U.S. ___, 116 S.Ct. 277, 133 L.Ed.2d 197 (1995). One of the other cases on which PIL relies not only did not hold that the furniture line in question was inherently distinctive, but that holding of no inherent distinctiveness was affirmed in the appellate court vacating a preliminary injunction on the grounds that the plaintiff likely could not show secondary meaning. L. &

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[7] The latest case dealing with the design of greeting cards found that a greeting card design featuring die cut images of animals, people, or objects was not inherently distinctive as it was merely "a refinement on the die-cut greeting card design" despite "its initial novelty within the greeting card industry." Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc., 59 F.3d 27, 33 (2nd Cir.1995).

J.G. Stickley, Inc. v. Canal Dover Furniture Co., Inc., 79 F.3d 258, 262-63 (2nd Cir.1996). Cf. Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373, 381-82 (2nd Cir.1997) (rejecting claim of inherent distinctiveness for product configuration of furniture line where plaintiff failed to detail what the unique combination of features involved was; noting caution where plaintiff seeks to protect an "array of products"). The third product line, books, would seem to be the most relevant, but none of these cases are good analogies to PIL's situation because none address the issue of inherent distinctiveness; instead, the cases either focus solely on likelihood of confusion, see, e.g., Simon & Schuster v. The Putnam Berkley Group, Inc., 1994 WL 689058 (S.D.N.Y.1994), or find secondary meaning and likelihood of confusion, see, e.g., Harlequin Enterprises Ltd. v. Gulf & Western Corp., 644 F.2d 946 (2nd Cir.1981); Time Inc. Magazine Co. v. Globe Communications Corp., 712 F.Supp. 1103 (S.D.N.Y.1989), or find that a trademarked cover design was strong and had acquired customer identification, in addition to likelihood of confusion. Cliff's Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc., 718 F.Supp. 1159, vacated on other grounds, 886 F.2d 490 (2nd Cir.1989).[8]

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[8] This line of cases also raises an additional problem with PIL's claims. The books at issue in Harlequin share almost all characteristics: (1) glossy white covers; (2) identical dimensions in height, width and thickness; (3) placement of series' number and price in similar type in the same place on the covers; (4) price; (5) collage of gold filigree with publisher's colophon (one a black and white harlequin framed by a gold diamond, one black silhouettes of a man and woman framed by a gold oval) on same place on the covers; (6) series' titles

(continued...)

*7 No reasonable jury could find that PIL's product configuration is inherently distinctive. The court also notes its reluctance to extend trade dress protection to product configurations involving such common elements, all of which serve to increase the price-point and aesthetics of the products and, hence, to increase the intrinsic desirability of the products. PIL's claims, if accepted, would use "trade dress protection [to] undermine restrictions in copyright and patent law that are

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[8] (...continued)
printed in similar black script with one word of the series' title appearing on each side of the colophon; (7) author's name printed in bold, colored capital letters under the collage; (8) book's title printed below the author's name on both books in black lettering; (9) bottom half of each cover being an illustration of a man and a woman in a romantic setting suggesting the book's story line. 644 F.2d at 949. Thus, the books involved in the trade dress infringement action involved more than just similar size, gloss, and even color on their covers—every element was similar. By contrast, PIL does not attempt to claim that its books and Landoll's books share similar typefont, use of trademarks, illustration, or title placement. Even more striking is Roulo, where the court actually found inherent distinctiveness. There, virtually every element was similar: (1) identically sized; (2) identical price; (3) single-faced (as opposed to imprinted on two or more faces); (4) on beige or cream-colored textured paper; (5) featuring handwritten messages; (6) written in brown ink; (7) using ellipses in the message; (8) flanking the messages with multiple colored stripes; (9) displayed identically in a four-sided, 32-card rack with each side displaying a single color scheme. 886 F.2d at 935, 937. The only distinction was that only the plaintiff's card used a foil stripe in its flanking stripes and only the defendant's card used a colored foil butterfly superimposed on the flanking stripes. Id. There, plaintiff had used these nine elements to produce a specific artistic impression and did not, like PIL does in this case, attempt to base a claim of inherent distinctiveness merely on the size and medium (in Roulo, textured paper) used.

designed to avoid monopolization of products and ideas." Jeffrey Milstein, 58 F.3d at 32. If every time a product is introduced into the market including some "new" combination of features, the product received trade dress protection—regardless of a lack of distinctiveness in the product—"competition would be hindered." Thomas & Betts, 65 F.3d at 657; Turtle Wax, 781 F.Supp. at 1321. The ability to copy product features which are intrinsically valuable to consumers "is not only good, it is a federal right—a necessary component tc the patent system's grant of limited monopolies." Thomas & Betts, 65 F.3d at 657. This court is unwilling to extend trade dress protection as far as PIL needs it to go in order to protect PIL's product configuration: namely, to protect any new combination of features.[9]

Thus, Landoll's summary judgment motion is granted as to count one of PIL's complaint (Lanham Act trade dress infringement). While Landoll labeled its motion as one for summary judgment "as to all counts of the

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[9] The context of this particular case highlights the uneasy relationship between competition and trade dress protection. Here, the trade dress at issue is one which is good for display marketing. PIL has decided to pull its products from other display marketers in order to utilize its own display marketing company. But when the other display marketing companies arranged for another company to offer a competing product utilizing the features from PIL's books which make them good for display marketing, PIL sought to use trade dress protection to prevent Landoll's production of the books—which also would prevent PIL's competition in the display marketing area from offering a competing product. If precedents in the trade dress case law justified PIL's claims, the court would, of course, uphold its rights, but the court will not stretch the case law to effect this result.

complaint," neither side addressed the two state law counts and the court will not rule on the other counts without such argumentation by the parties.

IV. Functionality

Landoll also argues that PIL's product configuration is functional. The court will not rule on this issue, as PIL has failed to show that its trade dress either is inherently distinctive or has secondary meaning. The court will note, however, that Landoll's argument confuses "functional" in this area for "useful." As discussed above, PIL's product configuration is made up entirely of "functional" elements, i.e., elements which are useful. But "functionality" as used in prong 3 of the test for trade dress infringement is a term of art, referring not to the usefulness per se of a particular trade dress but to the necessity of having that trade dress available because alternate trade dresses cannot achieve the same benefits and, thus, protection of the trade dress would cripple competition. Abbott Laboratories v. Mead Johnson & Co., 971 F.2d 6, 21 (7th Cir.1992) (defendant "must not only point to certain advantages [of a product design], but also demonstrate that depriving [defendant] of these advantages will have a materially adverse impact upon its ability to compete effectively" against the plaintiff). Thus, it is not enough that Landoll demonstrate that PIL's product configuration is advantageous, which Landoll clearly has shown. Landoll would also have to demonstrate that offering another product configuration would either be so costly as to affect price adversely or that consumers or retailers "so prefer [PIL's product configuration] that no other [con-

figuration] will do." Id. Landoll, on the record as it currently stands, has offered neither evidence nor argument tending to show that PIL's product configuration is functional under the Abbott Labs standard.

V. Conclusion

*8 Defendant Landoll's motion for summary judgment is GRANTED as to count one of PIL's complaint. The case remains OPEN with regard to counts two and three of PIL's complaint. The court will not address Landoll's motion to strike PIL's survey regarding likelihood of confusion at this time. The parties are directed to address by memorandum the relevance of the survey to the remaining state law counts. PIL shall submit a memorandum by December 9, 1997 addressing the relevance of the survey, and Landoll shall submit a responsive memorandum by December 16, 1997. The matter of the survey shall be taken up at the pretrial conference.